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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,249	06/20/2003	Cynthia Kae Florkey	LUC-412/Florkey 6-6-14-6-	6690
32205 7590 09/24/2007 PATTI, HEWITT & AREZINA LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER COULTER, KENNETH R	
			ART UNIT 2141	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

10/601,249

Applicant(s)

FLORKEY ET AL.

Examiner

Kenneth R. Coulter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 20 is directed to instructions that are not implemented on a computer-readable storage medium.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Roseman (U.S. Pat. No. 6,608,636) (Server Based Virtual Conferencing).

4.1 Regarding claim 1, Roseman discloses an apparatus, comprising:

an application server component that receives an indication of one or more communication devices that are to receive one or more invitations to join a communication session (Fig. 2; title “**Server Based Virtual Conferencing**”; Abstract; col. 1, lines 34 – 63 “**host computer**”; col. 3, line 63 – col. 4, line 27; col. 5, lines 20 – 25, 31 – 34);

wherein the one or more invitations comprise a photo (col. 5, lines 20 – 25 “One option is to allow the Requester to instruct the host computer to place a small picture of the Requester onto the Invitee’s computer display. The picture beckons the Invitee’s attention ...” ; col. 5, lines 31 – 34 “**If the Invitee wishes to respond to the Requester, the Invitee clicks a pointing device onto the picture, and the host establishes video and audio connections between the two local computers.**”);

wherein the application server component notifies the one or more communication devices of the one or more invitations to join the communication session (Abstract; col. 5, lines 20 – 25, 31 – 34);

wherein upon acceptance of at least one of the one or more invitations by at least one of the one or more communication devices, the application server component connects the at least one of the one or more communication devices to the communication session (Abstract; col. 1, lines 34 – 63; col. 5, lines 20 – 25, 31 – 34).

4.2 Per claim 2, Roseman teaches the apparatus of claim 1, wherein the one or more communication devices comprise one or more first communication devices (Fig. 2; Abstract; col. 3, line 63 – col. 4, line 27); and wherein the application server component receives the indication of the one or more first communication devices from one or more second communication devices (Fig. 2; Abstract; col. 3, line 63 – col. 4, line 27).

4.3 Regarding claim 3, Roseman discloses the apparatus of claim 2, wherein the one or more second communication devices are involved in the communication session; wherein the application server component notifies the one or more first communication devices of the one or more invitations to join the communication session with the one or more second communication devices (Fig. 2; Abstract; col. 3, line 63 – col. 4, line 27).

4.4 Per claim 4, Roseman teaches the apparatus of claim 3, wherein the application server component identifies a match between the one or more invitations and the

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acceptance of the one or more of the one or more invitations (col. 6, lines 9 – 13; col. 7, lines 29 – 53; col. 9, line 61 – col. 10, line 8); wherein the application server component employs the match to indicate to one or more control components a call identification of the communication session (col. 6, lines 9 – 13; col. 7, lines 29 – 53; col. 9, line 61 – col. 10, line 8); wherein the one or more control components employ the call identification to connect the one or more of the one or more first communication devices to the one or more second communication devices in the communication session (col. 6, lines 9 – 13; col. 7, lines 29 – 53; col. 9, line 61 – col. 10, line 8).

4.5 Regarding claim 5, Roseman discloses the apparatus of claim 2, wherein the one or more first communication devices comprise a communication device, wherein the application server component activates an indicator of an invitation of the one or more invitations on the communication device, wherein the indicator persists until an action occurs on the invitation (col. 5, line 46 – col. 6, line 6 “invitation card”).

4.6 Per claim 6, Roseman teaches the apparatus of claim 5, wherein the indicator persists on a display of the communication device, wherein upon the acceptance of the invitation by the communication device, the user of the communication device employs the indicator to initiate a connection to the communication session; wherein the application server component connects the communication device to the communication session (col. 5, line 46 – col. 6, line 6).

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4.7 Regarding claim 7, Roseman discloses the apparatus of claim 5, wherein the action comprises an acceptance of the invitation by the communication device (col. 5, line 46 – col. 6, line 6; col. 6, lines 25 – 33); wherein upon receipt of the acceptance of the invitation by the communication device, the application server component sends one or more notifications of the acceptance of the invitation by the communication device to the one or more second communication devices (col. 5, line 46 – col. 6, line 6; col. 6, lines 11 – 33).

4.8 Per claim 8, Roseman teaches the apparatus of claim 5, wherein the action comprises a withdrawal of the invitation by one or more of the one or more second communication devices; wherein prior to an acceptance of the invitation, the one or more of the one or more second communication devices send the withdrawal to the application server component (col. 6, lines 11 – 33).

4.9 Regarding claim 9, Roseman discloses the apparatus of claim 8, wherein upon receipt of the withdrawal, the application server component removes the indicator of the invitation from the communication device (col. 5, lines 46 – 65; col. 11, lines 51 – 67).

4.10 Per claim 10, Roseman teaches the apparatus of claim 5, wherein the action comprises a rejection of the invitation by the communication device (col. 5, line 46 – col. 6, line 6; col. 6, lines 11 – 33); wherein prior to an acceptance of the invitation, the communication device sends the rejection to the application server component (col. 6,

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lines 11 – 33).

4.11 Regarding claim 11, Roseman discloses the apparatus of claim 10, wherein upon receipt of the rejection, the application server component sends one or more notifications of the rejection to the one or more second communication devices (col. 6, lines 11 – 33).

4.12 Per claim 12, Roseman teaches the apparatus of claim 5, wherein the action comprises a completion of the communication session (col. 5, line 46 – col. 6, line 6; col. 6, lines 11 – 33); wherein upon completion of the communication session prior to an acceptance of the invitation, the application server component sends a notification to the communication device of the completion of the communication session (col. 5, line 46 – col. 6, line 6; col. 6, lines 11 – 33); wherein the application server component removes the indicator of the invitation from the communication device (col. 5, lines 46 – 65; col. 11, lines 51 – 67).

4.13 Regarding claim 13, Roseman discloses the apparatus of claim 1, wherein the communication session comprises a voice conference call, wherein upon acceptance of an invitation of the one or more invitations by a communication device of the one or more communication devices, the application server component connects a user of the communication device into a voice conversation with one or more participants in the communication session (col. 5, line 46 – col. 6, line 6; col. 6, lines 11 – 33).

4.14 Per claims 14 – 20, 24, and 25, the rejection of claims 1 – 13 under 35 USC 102(e) (paragraphs 4.1 – 4.13 above) applies fully.

4.15 Regarding claim 21, Roseman discloses the apparatus of claim 1, wherein the communication session comprises a data session or a voice conference call (Abstract “multiple parties are linked by both video and audio media”; col. 3, lines 53 – 56 “voice and message interaction among the participants”; col. 6, lines 31 – 33 “attend the meeting in customary ways, such as by telephone”).

4.16 Per claim 22, Roseman teaches the apparatus of claim 1, wherein the indication comprises a phone number, an email address or an instant message account name (col. 10, lines 30 – 45).

4.17 Regarding claim 23, Roseman discloses the apparatus of claim 5, wherein the indicator comprises an icon, a tone, and a light (col. 5, lines 35 – 44 “a knocking (or chiming) sound”; col. 5, line 46 – col. 6, line 6 “The invitation card is an active icon”).

Response to Arguments

5. Applicant's arguments filed 8/8/07 have been fully considered but they are not persuasive.

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With regard to the 101 rejection of claim 20, Applicant argues that the specification limits the instructions as implemented on “recordable data storage medium 114 of the application server 108 and the communication devices 102, 103, and 104.”

Examiner disagrees.

The Examiner notes that specification depicts an alternative embodiment, namely a “computer-readable signal-bearing media ...” (p. 15, lines 13 – 14), wherein “the computer-readable signal-bearing medium comprises a modulated carrier signal transmitted over a network comprising or coupled with the apparatus 100 ...” (p. 15, lines 19 – 20).

Therefore, as stated in **MPEP 2106.01**, “when nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic **carrier signal**, it is **not statutory** since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic **carrier signal**, does not make it statutory.”

As seen in MPEP 2106.01, claim 20 is nonstatutory.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Crane U.S. Pat. Pub. No. 2003/0220980 Method and System for
Providing a Computer Network-Based Community-Building Function Through User-
To—User Ally Association

A community building system that allows the group host to invite allies by clicking on the pictures of the allies (paragraph 114).

Li et al. U.S. Pat. Pub. No. 2003/0115153 Identifier Management in
Message Transmission System

Li discloses an information sharing apparatus that “generates an image inviting the user to click on the image to join the information utility” (paragraph 70).

Salesky. U.S. Pat. No.6,343,313 Computer Conferencing System With
Real-Time Multipoint, Multispeed, Multi-Stream Scalability

A conference system with a shared image area.

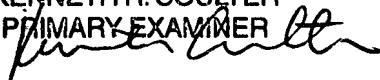
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KENNETH R. COULTER
PRIMARY EXAMINER



krc